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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,073	06/30/2000	CONNIE T MARSHALL	ODS-9	2964
1473 7590 01/29/2007 FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER MCCULLOCH JR, WILLIAM H	
			ART UNIT	PAPER NUMBER
			3714	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/29/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/609,073	MARSHALL ET AL.	
	Examiner	Art Unit	
	William H. McCulloch Jr.	3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-19 and 38-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-19 and 38-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to an appeal brief filed 7/19/2006. In view of the newly applied interpretation of claimed subject matter, new grounds of rejection, and an earnest endeavor to further clarify the record, prosecution is hereby reopened.

#### ***Claim Interpretation***

2. Claim 19 is directed in pertinent part toward 1) allowing a user to create and place a wager for a given race; 2) automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race; and 3) recording the given race. The term "opportunity" is defined as a situation or condition favorable for attainment of a goal (Random House Unabridged Dictionary). Therefore, automatically providing an opportunity to record a race in response to placing a wager, as stated in (2) above, is interpreted as automatically (without additional effort) providing an opportunity (favorable situation or condition) to record a race in response to (after) placing a wager. An analogous interpretation is applied to claim 48. As described below, such features are anticipated by the prior art.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11, 14, 15, 38, and 43-44 (with claims 13 and 39-42 by dependency) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 11, 14, 15, 38 and 43-44 describe "user equipment" as is recited in independent claims 19 and 48. Claims 19 and 48 are directed in pertinent part toward implementing an interactive wagering application on "user equipment". It is clear from the specification (see at least the Summary of the Invention) that the "user equipment" is made up of various devices such as telephone equipment and television equipment. However, it is also clear from the specification that such equipment must work together to produce the system described in independent claims 19 and 48. As such, claims 11, 14, 15, 38, and 43-44 are not enabled by the specification because such claims require that "user equipment" is an individual element, such as user telephone equipment (claims 15 and 44). At best, the specification supports a claim that user equipment comprises user telephone equipment, because user telephone equipment alone is not adequately enabled to perform the functions set forth in claims 19 and 48. Similar logic applies to the other above-rejected claims. Applicant is required to provide an appropriate correction to the claims. For the purposes of this examination, the examiner will interpret claims 11, 14, 15, 38, and 43-44 as reciting, "user equipment comprises" X, where X is user television equipment, user computer equipment, or user telephone equipment, depending upon the content of a given claim. Claims 13 and 39-42 depend from the above-rejected claims and are thus also rejected under 35 U.S.C. 112.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 2-7, 11-19, 38, and 39-48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 17, 37-41, 46 and 49 of U.S. Patent No. 6,004,211 to Brenner et al. (hereinafter Brenner '211).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Brenner '211 fully encompass the instant claims, as shown in view of the interpretation set forth above.

7. Claim 39 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 37 of Brenner '211. Brenner '211 teaches a user terminal configured to perform the functions necessary for operation (e.g. the user terminal contains the "control circuitry" as described in instant claim 39). Brenner '211 lacks describing that the user terminal is a set-top box. A set-top box, as described in the context of the claims, is merely a device dimensioned to be capable of sitting on top

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of a monitor. Such a limitation changes the size of the device, but does not affect the way in which the device operates. As such, instant claim 39 is not patentably from claim 37 of Brenner '211. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). (The Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.) Therefore, it would have been an obvious matter of choice, well within the capabilities of one of ordinary skill in the art at the time of invention to embody the control circuitry of Brenner '211 in a set-top box in order to minimize the size of the device so as to allow the device to sit atop a monitor (the monitor being required by Brenner '211 to operate).

8. Claims 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, and 5 of Brenner '211. Claims 1, 4, and 5 of Brenner '211 allow, in pertinent part, a user to select and view video clips of particular races using a user terminal. Brenner '211 lacks in describing that the recorded races are listed with corresponding track names, race numbers, or dates. However, it is clear from the claims of Brenner '211 that a user must be able to discern an individual race from a plurality of previously recorded races and input a request to view said race. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to list recorded races with their corresponding track names, race

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numbers, and/or dates in order to allow a user of the system to identify and select a particular race as is required by the claimed system of Brenner '211.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 2-9, 11-19, and 38-48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 5,830,068 to Brenner et al. (hereinafter Brenner '068).

Regarding claims 19 and 48, Brenner '068 teaches a method and system for a user at user equipment to interactively wager on races with an interactive wagering application implemented using the user equipment (see at least abstract, figs. 1, 2, 29, 30, and cols. 2-5). Brenner '068 further teaches a system and method step of allowing the user to create and place a wager for a given race (see at least abstract, figs. 3-7, 15, 31-34, 36-44, 46, 48-50, and cols. 2-5). Brenner '068 additionally teaches a system

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and method step of recording the given race (see at least figs. 30, 34, 49 and cols. 3:11-14, 4:65-5:3, and 27:65-28:15).

Further regarding claims 19 and 48, Brenner '068 teaches a system and method step of automatically providing the user with an opportunity to record the wagered upon race in response to the user placing the wager for the given race. Figure 31 shows a flow chart for placing a wager on a particular race, with figures 36-39 showing user interfaces for placing the wager. Box 486 of figure 31 shows the "Place Wager" selection, which instructs the system to Place Wager operation 510, and then returns to box 486. Therefore, Brenner '068 teaches a system and method step of allowing a user to create a wager for a given race. Box 486 is represented by the user interface of figure 39. The flow charts of figures 31, 32, and 34 (explained in cols. 23-28) and the user interfaces of figures 48-49 show that in response to placing the wager, the user *automatically* has the *opportunity* to record the wagered upon race by selecting menu choices "Other Race" and "Tape/VCR" to program a video recorder to record the race (see at least cols. 27:65-28:15). Therefore, in Brenner '068 the opportunity to record the race is provided automatically and in response to placing a wager.

Regarding claims 2 and 3, Brenner '068 states, "If 'tape/VCR' is selected at step 596 (FIG. 34), at step 606 (FIG. 34) user terminal 370 (FIG. 30) programs video recorder 424 (FIG. 30) with the appropriate recording information or actuates video recorder 424 (FIG. 30) at the time of the selected race. Thus, selecting 'tape/VCR' allows the selected race to be recorded" (col. 28:5-11). Therefore, selecting "yes" is anticipated by a user of Brenner '068 pressing "Tape/VCR" to actuate recording,



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whereas selecting "no" is anticipated by a user of Brenner '068 pressing any other button and/or not pressing "Tape/VCR".

Regarding claims 11, 38, and 40, Brenner '068 teaches that the user equipment is user television equipment, for example in the form of a "conventional television monitor" (col. 3:59-60).

Regarding claims 12 and 41, Brenner '068 teaches that a recording device may be a "conventional video cassette recorder" (col. 21:56-58).

Regarding claims 13 and 42, Brenner '068 teaches recording a given race with a digital video recorder indicated by the digitally-compressed video signals being processed, encoded, decoded, and transmitted by the video and data distribution system 368 and/or the user terminal 370 (see at least 27:46-64). The digital video recorder is further indicated by the recitation of a high capacity storage medium, suitable for recording races as they are received from racing video source 374, embodied in video and data distribution system 368 (see at least 27:39-45).

Regarding claims 14 and 43, Brenner '068 describes employing user computer equipment in the form of user terminal 122, which is described as being "preferably microprocessor-based [and] supports software capable of coordinating the receipt and display of racing data and the placing of wagers electronically" (col. 7:21-24). See also fig. 1 and col. 7:24-34.

Regarding claims 15 and 44, Brenner '068 teaches that user equipment is telephone equipment used to implement the interactive wagering application (see at least 7:35-54, 8:29-40).

Regarding claim 16, Brenner '068 teaches recording a race in real-time (see at least col. 6:55-62 and 17:65-18:40).

Regarding claims 17 and 47, Brenner '068 describes recording the race after it has taken place (see at least cols. 26:65-27:22).

Regarding claim 18, Brenner '068 teaches charging a fee for recording a given race (see at least col. 27:33-39).

Regarding claim 39, Brenner '068 discloses using a set-top box 434 disposed between display and processing circuitry 416 and monitor 378 (see at least fig. 30 and 22:13-15). Therefore, Brenner '068 teaches a set-top box wherein control circuitry is located, wherein the control circuitry is configured to allow the user to create and place a wager for a given race.

Regarding claims 6 and 45, Brenner '068 teaches a recording device located remote from the user equipment (see at least 7:4-20, 17:48-18:14, 21:63-22:12, and 27:23-29).

Regarding claims 4, 5, 7, and 46, as described above, Brenner '068 teaches recording racing videos on a videocassette, which is interpreted as a personal archive. Further support for the interpretation is found in above-cited sections of Brenner '068 regarding the user's own home equipment (e.g. the video cassette recorder), which is personal equipment and personal recording media (e.g. the video cassette).

Brenner'068 further describes using the interactive wagering application to allow the user to access the personal archive at the head end or at the user equipment and view

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previously recorded races in cols. 7:4-20, 17:48-18:14, 21:63-22:12, and 27:23-29. See also local mass storage device 578 (FIG. 3).

Regarding claims 8-9, Brenner '068 teaches listing previously recorded races in the personal archive with their corresponding track name and race number (see at least figs. 49-50 and descriptions thereof).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner '068. Brenner '068 teaches the interactive wagering system substantially as described above. Brenner '068 lacks in specifically disclosing that previously recorded races in the personal archive are listed with their corresponding date. As described in Brenner '068, players place wagers on specific races, which requires that the player be able to correctly identify the results of a given race, for example in order to select from a list a previously recorded race upon which a player has placed a wager. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide date information with previously recorded races in order to allow users to correctly identify when the race took place. See at least figs. 49-50 and descriptions thereof.

***Response to Arguments***

13. Applicant's arguments contained in an appeal brief filed 7/19/2006 regarding prior art rejections have been fully considered to but are not persuasive. To the extent that the arguments set forth by the applicant could still be applicable in view of the new grounds of rejection, the arguments have been answered in the rejections above.

14. Applicant's arguments contained in an appeal brief filed 7/19/2006 regarding double patenting rejections have been considered to the extent that they are still applicable in view of the new grounds of rejection, but are not persuasive. MPEP 804 requires the examiner to raise double patenting issues when applicant's claimed invention conflicts with an existing patent *as claimed*. Chart II-B (MPEP 804) indicates that a double patenting rejection in this instance is proper. Specifically, a double patenting rejection is proper when the claims conflict between an application and a patent, and: the inventions are not patentably distinct, the application and patent are currently owned but have different inventive entities, and there is no showing of common ownership at the time of applicant's invention or no joint research exclusion under 103(c) applies. Note that the chart allows both prior art rejections *and* obviousness-type double patenting rejections. Therefore, applicant's argument that Brenner '211 is prior art under 102(a) and therefore not available for double patenting is incorrect. The examiner further notes MPEP 804.03(IV), which indicates that the examiner should make "(A) any appropriate double patenting rejection(s), and (B) the appropriate prior art rejection(s) under 35 U.S.C. 102 and/or 35 U.S.C. 103 in the application being examined."

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

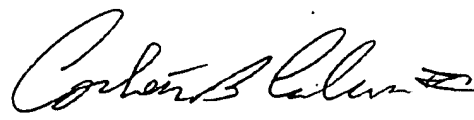
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